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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,072	08/15/2001	Robert G. Burke	T8466357US	8932
26912	7590	04/13/2005	EXAMINER	
GOWLING LAFLEUR HENDERSON LLP COMMERCE COURT WEST, SUITE 4900 TORONTO, ON M5L 1J3 CANADA			KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,072

Applicant(s)

BURKE ET AL.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species I (figures 1-5 and 7) in the reply filed on March 9, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 6 and 16-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 9, 2005. Claim 6 has been included above since this clearly reads on the non-elected embodiment shown in figure 10.

Drawings

3. The drawing change to figure 6 was received on Nov. 11, 2004 and this change is approved.
4. The drawings are objected to because the plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken, see CFR 1.84(h)(3). For example, A-A' in figures 2 and 3 should be changed to 2A-2A' and B-B' in figures 2 and 3 should be changed to 2B-2B'. Corresponding changes should also be made in the specification.
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3,8,9,10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following phrases: "longitudinal radius of curvature approximately coincident with the sagittal plane centre of mass of the calcaneus of said wearer's foot" and the "transverse radius of curvature approximately coincident with a long axis of rotation of said wearer's foot", in claims 3,8 and 9, are unclear and indefinite. It is not clear which curvature applicant is referring to. Is it the curve 11 shown in figure 5 or is it the curve 11 shown in figure 7? There is

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no clear support for this language in the claims and applicant's remarks on page 8 of the paper filed Nov. 4, 2004 adds further confusion.

In the last line of claim 10, applicant claims the catalyst apex as being "1% to 5% of the length of the wearer's foot" which is indefinite because applicant is trying to define the footwear with regard to an object (wearer's foot) that is variable. Perhaps applicant should change "the length of the wearer's foot" to "a length of the midsole/outsole".

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5317819 (Ellis).

Ellis teaches an article of footwear comprising an upper, a midsole/outsole having a heel region with the outer face having a convex curvature, said convex curvature has a longitudinal radius with the curvature approximately coincident with the sagittal plane centre of mass of the calcaneus of the wearer's foot (it would appear applicant is defining the curvature 11 as shown in figure 7) a region of enhanced flexibility in the range as claimed provided by a transversely extending groove (counter line 86 extending transversely across the sole unit in the metatarsal region; see figures 19F and 21, near the cross-section 19A and 20A). The outface of the sole unit as shown in figures 6, 11A-11E, 19E and 20E all have the curvature as claimed. The sole unit of Ellis is designed to approximate the barefoot of the wearer as does applicants invention, see col.

1, line 57 to col. 2, line 22 of Ellis. Also see, col. 11, lines 64-66 which clearly points out that these views are in the sagittal plane and contour to the contour of the bottom of the foot. All of the curves appear to pivot around the sagittal plane centre of mass of the calcaneus of the wearer's foot. Moreover, in case applicant is referring to the other plane going laterally across the sole (curve 11 as shown in figure 5), see figure 15 and 22B of Ellis, both show a curvature that appears to pivot around the sagittal plane centre of mass of the calcaneus of the wearer's foot.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5,7/4,8,9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '819 in view of either [US 2001/0005947 (Sordi) and/or D 334282 (Greene)].

Ellis teaches an article footwear substantially as claimed (see the rejection above) except for more than one transversely extending grooves. Ellis teaches only one groove as noted above. Both Sordi and Greene show the sole unit having more than one groove to provide increased flexibility; see grooves T1 and T2 on figure 5 of Sordi and figure 2 of Greene. It would have been obvious to provide the footwear of Ellis with more than one transverse groove, as taught by Sordi and/or Greene, to provide increased flexibility.

Regarding claims 7-9, Ellis teaches both curvatures as claimed as noted in the rejection above.

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12. Claims 10/2,10/4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claims 2,4 and 9, respectively above, and further in view of US 5404659 (Burke et al).

Burke teaches the midsole/outsole with a dome shaped catalyst having an apex with a maximum height from 5.28% to 7.6% of the length of the foot, see col. 4, lines 5-7. It would have been obvious to provide the sole unit as taught above with a dome shaped catalyst, as taught by Burke, to provide a more energy efficient footwear. Regarding the range of 1 to 5%, it would appear to be obvious to adjust the height of the apex of Burke, especially within 0.28%, to suit a particular foot or bone structure.

13. Claims 10/2,10/4, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claims 2,4 and 9, respectively above, and further in view of US 6301807 (Gardner).

Gardner teaches the midsole/outsole with a dome shaped catalyst having an apex with a maximum height from 1 to 5% of the length of the foot, see col. 4, lines 29-32. Burke also teaches the catalyst with receptacles having vertical sidewalls for accommodating a resilient member; see figures 9-14. It would have been obvious to provide the sole unit as taught above with a dome shaped catalyst and receptacle with vertical sidewalls, as taught by Gardner, to provide a more energy efficient footwear.

Response to Arguments

14. Applicant's arguments filed Nov. 4, 2004 have been fully considered but they are not persuasive.

The examiner has addressed and/or provided greater detail in the rejection above regarding applicant's arguments.

Regarding applicants attempt to contact the examiner back in September, it is deeply regretted that the examiner was unable to contact the applicant. This application has only been currently assigned to the present examiner. Upon review of the new grounds of rejection and newly cited art, the applicant is encouraged to review the art and rejection and contact the examiner at the number below to arrange an interview if desired.

Conclusion

15. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”


-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

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In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (**FORMAL FAXES ONLY**). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
April 11, 2005